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|---|-------------|----------------------|---------------------------------|-----------------------------|
| 09/878,518  | 06/11/2001  | Paula F. Delano      | END920010011US1                 | 4253                        |
| 23550 7590 12/13/2007<br>HOFFMAN WARNICK & D'ALESSANDRO, LLC<br>75 STATE STREET<br>14TH FLOOR<br>ALBANY, NY 12207 |             |                      | EXAMINER<br>ROBERTSON, DAVID    |                             |
|   |             |                      | ART UNIT<br>3623                | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>12/13/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

# Office Action Summary

Application No.

09/878,518

Applicant(s)

DELANO ET AL.

Examiner

Dave Robertson

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,11-22,24-27,29-32,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,11-22,24-27,29-32,34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is a Non-final office action, a first action after RCE, examining pending claims 1, 4-9, 11-22, 24-27, 29-32, 34 and 35.

#### ***Continued Prosecution Application***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/15/2007 has been entered.

#### ***Response to Amendment***

3. Applicant's amends claims 1, 7, 13, 16, 22, 26 and 31. Claims 1, 4-9, 11-22, 24-27, 29-32, 34 and 35 are pending.

#### ***Response to Arguments***

4. Applicant's arguments filed 10/15/2007 have been fully considered but they are not persuasive.
  - a. Applicant traverses the rejection under 35 USC 103(a) over the combination of Puri in view of Barritz and further in view of Fuerst and Canada as "lengthy, convoluted, and serpentine," and further, if such a combination is

Art Unit: 3623

obvious, that none of Puri, Barritz, Fuerst, or Canada, teach *wherein the business entity is a banking entity*.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's argument that the cited references do not teach *wherein the business entity is a banking entity*, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As there is no apparent structural or functional difference between performing the method *wherein the business entity is a banking entity*, compared to any other business entity, and because Puri teaches or suggests a business entity, the statement of intended use of the method for *banking entity* does not distinguish the method over the prior art.

b. Applicant argues the cited combination does not teach the amended limitation *wherein the priorities include one of: maximizing world wide web sales, providing customer access to data, and complying with data privacy regulations*.

However, whether the cited art teaches the limitation is immaterial with respect to the patentable weight to be given any particular priorities used in the step of *formulating a set of questions...based on a business strategy*. That is,

Art Unit: 3623

the particular priorities of the business strategy held in mind for the step *formulating the questions* is nonfunctional data at best. Even giving weight to the particular priorities as having bearing and effect on the resulting *content* of the questions formulated, the *content* of the resulting questions is nonfunctional data as the particular questions asked in the survey also have no structural or functional bearing on the steps of the method to follow.

Still more, even giving *full weight* to the limitation *wherein the priorities include one of...complying with data privacy regulations*, Examiner notes that Puri teaches "Security" as a category of questions surveyed in the Netscape Smart Configurator tool (see Puri, Figure 4), and as one of ordinary skill in the art would recognize, questions related to security encompass *data privacy security* as may be required by local (business) regulations and nonetheless, a high priority of all computer configurations.

c. Applicant argues the cited combination does not teach or suggest *wherein the questions are directed to <an enumerated list of types of questions asked>*.

However, and similarly as above in b) for the particular priorities, the step of *formulating a set of questions* and the resulting types of questions asked are descriptive material, nonfunctional data with respect to the method. The *types* of questions asked also carry no patentable weight, provided the prior art is capable of presenting questions of various types of content, which Puri clearly demonstrates (see again Figure 4).

5. For reasons given above, the rejections of the prior office action are maintained.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-9, 11-22, 24-27, 29-32, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri (U.S. 6,064,982) and Barritz et al. (U.S. 6,938,027) and further in view of Fuerst (U.S. 6,189,029) and Canada et al (U.S. 6,767,660).

Puri discloses, generally, automated methods and a system for surveying the software application needs of a customer to determine what features/options of an application software package are needed for a business entity and therefore worth purchasing from the software vendor. Barritz discloses automated methods for inventorying software applications of a business entity. Fuerst discloses an automated, general purpose web tool for creating arbitrary surveys with multiple choice questions including multiple choice and "range-type" responses. Canada discloses the use of such multiple response questions in surveying a business entity for an arbitrary strategy of the business entity.

As per claim 1, Puri discloses a computer-implemented method for analyzing software application needs of a business entity to determine whether to remove an entity software application, comprising the steps of: formulating a set of questions related to the entity software application based on a business strategy corresponding to

Art Unit: 3623

the business entity, wherein the set of questions are tailored to assess the software application needs of the business entity and to measure how well the entity software application is meeting the software application needs (col. 1, lines 33-35 and 47-53; col. 3, lines 32-34; col. 5, lines 1-15 and 26-30; Figure 4; The system takes the business entity through a series of interactive questions to learn more about the application needs of the business entity. Item 52 in Figure 4 lists specific software application needs such as information publishing and electronic commerce. The business entity identifies its needs by checking the boxes (item 51 in Figure 4) most relevant to its needs. The needs assessment process measures how well the entity software application is meeting the software application needs of the business entity by recommending products that will actually meet the business entity's software application needs. In other words, a product is recommended only if it is determined in the needs assessment that the business entity needs the product, which means the business entity does not have a current product that meets that particular software application need (i.e., a current software application is not meeting the software application needs of the business entity well.); and receiving entity responses to the set of questions (col. 5, lines 3-8; Figures 4: entity responses are received through an interactive interface).

Puri does not expressly disclose inventorying a set of entity software applications that are *currently used by the business entity*. Although Puri does disclose a needs assessment through which a business entity identifies technology areas in which they desire software applications (see Figure 4). By identifying technology needs, such as a desire to enhance a web site (statement 4 in Figure 4), a business entity is identifying

the hardware and software they are currently using (i.e., in order to have a functioning web site to begin with, certain hardware and software applications must be in use (such as web servers)).

Barritz discloses products that exist that inventory software products that have been installed on a computer system (col. 2, lines 47-55). Barritz also discloses a product for monitoring software products installed on a computer system and their usage (col. 6, lines 17-25). Puri and Barritz are analogous in that each is concerned with providing products/software applications to entities that entities will use based on their products/software applications needs/requirements. Identifying the software applications that a business entity is currently using, while also receiving their technology needs, provides a recommendation tool such as that of Puri with more comprehensive data to conduct a needs analysis and product recommendation. For example, if a business entity identifies a particular publishing application that it is currently using while also identifying publishing as a technology area that needs improvement, the recommendation tool would not recommend the publishing application that the business entity is currently using (at least not without some modification) as it obviously is not sufficient for the business entity's needs. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Puri to inventory a set of entity software applications that are currently used by the business entity as doing so provides the recommendation tool with more comprehensive data with which to conduct a needs assessment, thereby enhancing the analysis and ultimate product recommendation performed by the recommendation tool.



Puri also does not teach *weighting the possible responses where the weighting comprises assigning a value for each possible response to the set of questions, wherein there are at least three possible responses to the question in the set of questions.*

Whereas, Puri discloses weighting possible responses to the set of questions based on the business strategy by allowing an entity to identify needs that are important for its business (col. 5, lines 3-15; and Figure 4: the system weighting the response as indicative of a particular need and guiding the entity to answer more questions relating to that need, thereby emphasizing the need.); however Puri does not expressly teach there are at least three possible responses to each question or assigning a value to each possible response to the set of questions.

As is well-known in the art of survey design, Fuerst discloses an automated, general purpose web tool for creating arbitrary surveys with multiple choice questions including multiple choice and “range-type” responses (see Figure 8 and related discussion). Canada discloses an example of the use of such multiple choice and range-type “1=low to 5=high” responses in surveying a business entity for an arbitrary strategy of the business entity (see Canada Figure 3D and related discussion). It would have been obvious to one of ordinary skill in the art at the time of invention responses to questions on a survey of the needs of a business entity, would have employed such multiple choice and range-type questions to further distinguish the gradation of the respondents’ assessment of the need for a particular capability in the software application (as in Puri’s example business need survey), thereby providing a more accurate and precise assessment of the need. Inherent to the implementation of such

multiple choice and range-type questions, is the assigning of different values or weights to the responses to each question and using such weights in analysis of the survey responses.

Puri does not expressly disclose determining, based on entity responses, whether to remove the entity software application. Barritz discloses determining, based on entity responses, whether to remove the entity software application (col. 1, lines 32-35 and 40-46; col. 6, lines 25-29). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Puri to determine whether to remove an entity software application because doing so aids the entity in being more cost efficient and making better decisions about products it will use, as removing an entity software application is typically done when a software application is considered obsolete or underused (see Barritz, col. 2, lines 8-12; col. 6, lines 25-29).

As per claim 4, Puri discloses the method of claim 1, further comprising the step of analyzing the received responses to make a set of recommendations (col. 6, lines 5-13 and 43-46; The system provides recommendations to the entity based on the application needs assessment. The application needs assessment includes an interactive tool through which the entity selects from a predetermined question/answer session.).

As per claim 5, Puri discloses the method of claim 1, further comprising the step of generating a report based on the received entity responses (Figure 9).

Art Unit: 3623

As per claim 6, Puri discloses the method of claim 1, wherein the entity software applications are grouped by business process (item 42 in Figure 4 shows a business process grouping of the needs to be identified by the entity).

Claims 7-9, 11-22, 24-27, 29-32, 34 and 35 recite substantially similar subject matter as claims 1 and 4-6 above. Therefore, claims 7-35 are rejected on the same basis as claims 1 and 4-6.

Art Unit: 3623

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is 571-272-8220. The examiner can normally be reached on 8:15am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dcr

*DCR*  
*12/16/07*

*Romain Jeanty*  
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PRIMARY EXAMINER